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| 10/698,550 | 11/03/2003 | Narasimha K. Nayak | 08950.0003 | 9937 |

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| EXAMINER |
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CONTEE, JOY KIMBERLY

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| ART UNIT | PAPER NUMBER |
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2686

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/698,550 | NAYAK, NARASIMHA K. | |
| | Examiner | Art Unit | |
| | Joy K Contee | 2686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05/04/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejection's under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-16,18,19,21 and 23-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Tng et al. (Tung), U.S. Patent No. 5,859,979.

Regarding claim 1, Tung discloses a method for establishing communication between a first wireless terminal and a second wireless terminal, wherein the first wireless terminal may have at least one functional capability that the second wireless terminal may not have, the method comprising: receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of the at least one functional capability that the second wireless terminal may not have; determining whether the second wireless terminal has the at least one functional capability; and establishing the communication between the first wireless terminal and the second wireless terminal including use of the at least one functional capability, when it is determined that the second wireless terminal has the at least one functional capability (col. 1, line 54 to col. 2, line 9).

Regarding claim 2, Tung discloses the method of claim 1 further comprising establishing the communication between the first wireless terminal and the second wireless terminal without the use of the at least one functional capability, when it is determined that the second wireless terminal does not have the at least one functional capability (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 3, Tung discloses the method of claim 2, wherein the at least one functional capability includes at least one of video call capability and multimedia capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 4, Tung discloses the method of claim 2 further comprising: downgrading the communication between the first wireless terminal and the second wireless terminal to voice communication when it is determined that the second wireless terminal does not have the at least one functional capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 5, Tung discloses the method of claim 4 further comprising: downgrading the communication by splitting the communication into two streams (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 6, Tung discloses the method of claim 5, wherein the two streams comprise a voice only stream between the first wireless terminal and the second wireless terminal and a video stream between the first wireless terminal and a video server (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 7, Tung discloses the method of claim 5, further comprising forwarding the signal to a video gateway and setting up a video stream between the first wireless terminal and a video server(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 8, Tung discloses a system for establishing communication between a first wireless terminal and a second wireless terminal, wherein the first wireless terminal may have at least one functional capability that the second wireless terminal may not have, the system comprising: means for receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of the at least one functional capability that the second wireless terminal may not have; means for determining whether the second wireless terminal has the at least one functional capability; and means for establishing the communication between the first wireless terminal and the second wireless terminal including use of the at least one functional capability, when it is determined that the second wireless terminal has the at least one functional capability (col. 1,lines 54 to col. 2,line 9).

Regarding claim 9, Tung discloses the system of claim 8, wherein the means for establishing communication between the first wireless terminal and the second wireless terminal establishes a communication between the first wireless terminal and the second wireless terminal without the use of the at least one functional capability, when it is determined that the second wireless terminal does not have the at least one functional capability (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 10, Tung discloses the system of claim 9, wherein the at least one functional capability includes at least one of video call capability and multimedia capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 11, Tung discloses the system of claim 9 further comprising: means for downgrading the communication between the first wireless terminal and the second wireless terminal to voice communication when it is determined that the second wireless terminal does not have the at least one functional capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 12, Tung discloses the system of claim 11, wherein the means for downgrading the communication downgrades the communication by splitting the communication into two streams(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 13, Tung discloses the system of claim 12, wherein the two streams comprise a voice only stream between the first wireless terminal and the second wireless terminal and a video stream between the first wireless terminal and a video server(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 14, Tung discloses the system of claim 12 further comprising: means for forwarding the signal to a video gateway; and means for setting up a video session between the first wireless terminal and a video server(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 15, Tung discloses a method for establishing communication between a first wireless terminal and a second wireless terminal, the method comprising: receiving a call signal from the first wireless terminal to establish a video session between the first wireless terminal and the second wireless terminal; querying a database to determine whether the second wireless terminal has video capability; if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway; setting up a video session between the first wireless terminal and a video server; and setting up a non-video session between the first wireless terminal and the second wireless terminal (col. 1, line 54 to col. 2, lines 9).

Regarding claim 16, Tung discloses the method of claim 15 further comprising the video server playing a video announcement for the first wireless terminal informing the first wireless terminal of a lack of the video capability in the second wireless terminal (col. 1, line 54 to col. 2, line 9 and col. 3, line 66 to col. 4, line 25).

Regarding claim 18, Tung discloses a system for establishing communication between a first wireless terminal and a second wireless terminal, the system comprising: means for receiving a call signal from the first wireless terminal to establish a video session between the first wireless terminal and the second wireless terminal; means for querying a database to determine whether the second wireless terminal has video capability; means for setting up a video session between the first wireless terminal and a video server; and means for setting up a non-video session between the first wireless terminal and the second wireless terminal (col. 1, line 54 to col. 2, line 9 and col. 3, line 66 to col. 4, line 25).

Regarding claim 19, Tung discloses the system of claim 18 further comprising means for playing a video announcement for the first wireless terminal informing the first wireless terminal of a lack of the video capability in the second wireless terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 21, Tung discloses a system for establishing communication between a first wireless terminal and a second wireless terminal, the system comprising: at least one mobile switching center for receiving a call signal from the first wireless terminal to establish at least one video session between the first wireless terminal and the second wireless terminal; at least one call processing module for querying at least one of a home location register and a visitor location register to determine whether the second wireless terminal has a video capability, for setting up at least one video session between the first wireless terminal and a video server, and for setting up at least one non-video session between the first wireless terminal and the second wireless terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 23, Tung discloses the system of claim 21, wherein the at least one call processing, module is resident in a video gateway (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 24, Tung disclose the method for establishing communications between terminals in a wireless system, the method comprising: receiving a signal to establish a call between a call originating terminal and a call receiving terminal; and establishing, as a function of call processing functionality available to the call receiving terminal, the call between the call originating terminal and the call receiving terminal.

Regarding claim 25, Tung discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of at least one call processing capability, when it is determined that the call receiving terminal does not have the at least one call processing capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 26, Tung discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of at least one call processing capability, when it is determined that the call initially requires a call processing capability not available to the call receiving terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 27, Tung discloses the method of claim 24, wherein establishing the communication between the call originating terminal and the call receiving terminal further comprises establishing the call without the use of video call capability, when the call originating terminal has video call capability, but the call receiving terminal does not have video call capability (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 28, Tung discloses the method of claim 25, wherein the at least one call processing capability includes at least one of video call capability and multimedia capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 29, Tung discloses the method of claim 25 further comprising: downgrading the communication between the call originating terminal and the call

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receiving terminal to voice communication when it is determined that the call receiving terminal does not have the at least one call processing capability(col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 30, Tung discloses the method of claim 29 further comprising: downgrading the communication by splitting the communication into two streams.

Regarding claim 31, Tung discloses the method of claim 30, wherein the two streams comprise a voice only stream between the call originating terminal and the call receiving terminal and a video stream between the call originating terminal and a video server (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 32, Tung discloses the method of claim 30, further comprising forwarding the signal to a video gateway and setting up a video stream between the call originating terminal and a video server (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

.Regarding claim 33, Tung discloses in a wireless system having a plurality of terminals for processing calls, wherein any differences in call processing functionality between the terminals may not be known to associated users when initiating calls, a method for connecting calls between terminals comprising: establishing a new call between an originating terminal and a terminating terminal, the new call reflecting call processing functionality available to the originating terminal regardless of call processing functionality available to the terminating terminal and invoked when placing the new call, such that any adjustments required to establish the new call are made if

the new call requires specific call processing functionality not available to the terminating terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Regarding claim 34, Tung discloses in a wireless system having a plurality of terminals for processing calls, wherein any differences in call processing functionality between the terminals may not be known to associated users when initiating calls, a method for connecting calls between terminals comprising: an originating terminal initiating a new call for a terminating terminal, the new call reflecting call processing functionality available to the originating terminal regardless of call processing functionality available to the terminating terminal and invoked when placing the new call; the terminating terminal making adjustments required to establish the new call if the new call requires specific call processing functionality not available to the terminating terminal (col.1,line 54 to col. 2,line 9 and col.3,line 66 to col.4,line 25).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17,20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tung, in view of Gustafsson, U.S. Patent No. 6351,647.

Regarding claims 17,20 and 22, Tung discloses the method of claims 15,18 and 21, respectively, but fails to disclose wherein the database is at least one of a home

location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center.

In a similar field of endeavor, Gustafsson discloses wherein the database is at least one of a home location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center. (col. 2, lines 65 to col. 3, line 19).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Tung include the HLR and VLR for the purpose of allowing information to be held in the wireless part of the network.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corjens et al. U.S. Patent No. 5526037 discloses a method for remotely controlling a peripheral device in a videoconferencing system.

Dimolitsas et al. U.S. Patent No. 5488653 discloses a facsimile interface unit with enhanced capabilities negotiation.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 571.272.7906. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571.272.7905. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC


JOVIS CONTEE
PATENT EXAMINER

03/23/05